

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 7, 2004. In order to advance prosecution of this Application, Claims 1-3 and 8-16 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

Claims 9 and 15 have been amended to be drawn to the elected species. Moreover, the elected species clearly supports the language of Claim 7. With respect to Claim 6, Applicant's specification states at page 29, lines 25-27, that the insole 816 may have similar characteristics as outsole 715, which at page 22, lines 2-5, provides for a cavity between rear plane 727 and forward plane 729. Therefore, Applicant respectfully requests reinstatement of Claims 6, 7, 9, and 15.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. Attached herewith is a replacement drawing sheet addressing matters raised by the Examiner. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a).

Claims 1-5, 8, 10-14, and 16-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-3, 10-12, and 16 have been amended to address matters raised by the Examiner. Therefore, Applicant respectfully submits that Claims 1-5, 8, 10-14, and 16-20 are in accordance with 35 U.S.C. §112, second paragraph.

Claims 1, 2, 10, 11, 13, 14, and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lodispoto. Independent Claims 1, 11, and 16 recite in general an upper, an insole having a structure that places a wearer's foot in a position where the wearer's heel is closer to a walking

surface than the wearer's toes during normal wearing conditions or a dorsiflexion position, and an outsole. By contrast, the top member or insole of the wooden shoe in the Lodispoto patent cannot by itself place a wearer's foot in position where a wearer's heel is closer to a walking surface than a wearer's toes as provided in the claimed invention without the functionality of its bottom member. Therefore, Applicant respectfully submits that Claims 1, 2, 10, 11, 13, 14, and 16 are not anticipated by the Lodispoto patent.

Claims 1-5, 8, 10-14, and 16-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robinson. Independent Claims 1, 11, and 16 recite in general an insole that has a structure to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions or in a dorsiflexion position. By contrast, the insole 30 of the Robinson patent is substantially planar and cannot provide the structure by itself as provided by the claimed invention without the use of a separate reverse wedge positioned under the insole. Therefore, Applicant respectfully submits that Claims 1-5, 8, 10-14, and 16-20 are not anticipated by the Robinson patent.

Claims 3-5, 12-14, and 16-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Snabb, et al. As stated above, the claimed invention requires an insole with a structure to place the wearer's heel closer to a walking surface than the wearer's toes or in a dorsiflexion position. By contrast, the Snabb, et al. patent uses an outsole to attempt to provide the claimed structure. Moreover, Claims 4, 13, and 18 require that the structure of the insole changes at a substantially halfway point along the shoe. The Snabb, et al. patent clearly shows the change in structure at the toe area of the shoe, well away from the halfway point of the

shoe. Therefore, Applicant respectfully submits that Claims 3-5, 12-14, and 16-20 are not anticipated by the Snabb, et al. patent.

Claims 8 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson or Snabb, et al. Independent Claim 1, from which Claim 8 depends, and Independent Claim 16, from which Claim 20 depends, have been shown above to be patentably distinct from the Robinson and Snabb, et al. patents. Therefore, Applicant respectfully submits that Claims 8 and 20 are patentably distinct from the Robinson and Snabb, et al. patents.

Claims 1-5, 8, and 10-12 stand rejected under the judicially created doctrine of double patenting over Claims 1-6 of U.S. Patent No. 6,131,315. U.S. Patent No. 6,131,315 only provides disclosure through FIGURE 10 and does not include a FIGURE 14 of the elected species or any disclosure associated therewith as provided in Applicant's specification. Thus, the elected species of FIGURE 14 is not disclosed in U.S. Patent No. 6,131,315. Therefore, Applicant respectfully submits that a Terminal Disclaimer is not necessary in this Application with respect to U.S. Patent No. 6,131,315.

Claims 1-5, 8, 10-14, and 16-20 stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-6 of U.S. Patent No. 6,131,315 in view of Lodispoto, Robinson, or Borgeas. As stated above, a Terminal Disclaimer is not necessary in this Application with respect to U.S. Patent No. 6,131,315.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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A handwritten signature in dark ink, appearing to read "Charles S. Fish", is written over the typed name.

Charles S. Fish

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FIG. 12

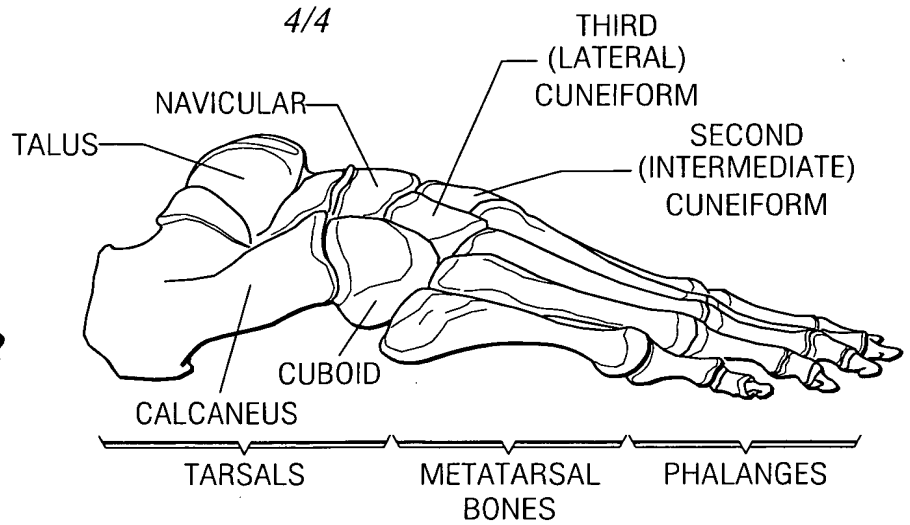


FIG. 13

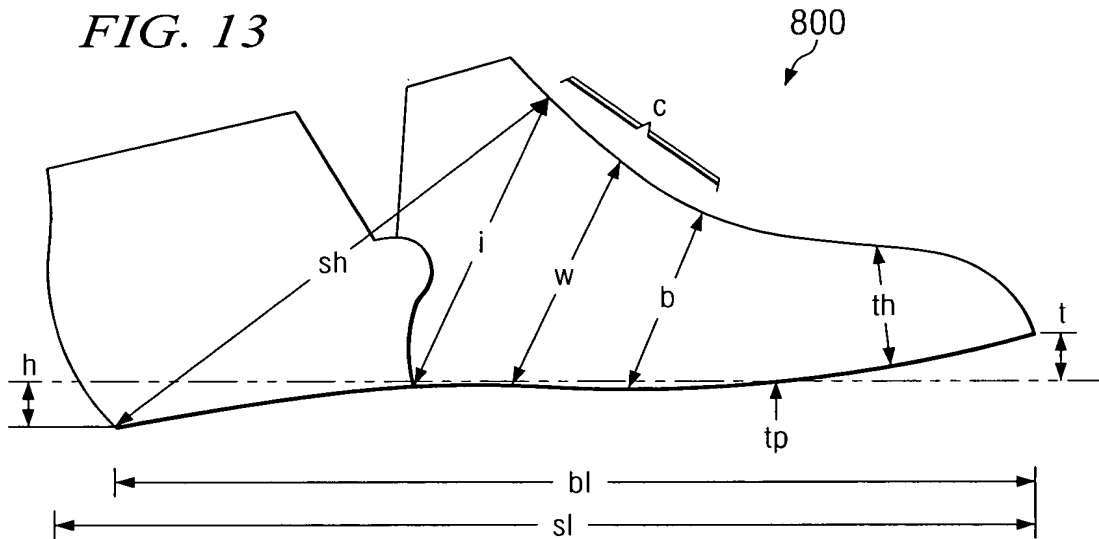


FIG. 14

